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08/13/2008

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EXAMINER

POLLACK, MELVIN H

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/939,369	<b>Applicant(s)</b> CHAUVIN ET AL.	
	<b>Examiner</b> MELVIN H. POLLACK	<b>Art Unit</b> 2145	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 40-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)                           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application                 |
| Paper No(s)/Mail Date _____  | 6) <input checked="" type="checkbox"/> Other: <u>see attached office action</u> . |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 10 June 2008 have been fully considered but they are not persuasive. An analysis of the arguments is provided below. Applicants may respond with an Appeal Brief.
2. Applicant argues that examiner does not show that "the requested service is partially outside of a submitting requestor's area of expertise, but which is required to fulfill a non-member customer's order." In making the argument, applicant focuses solely on the examiner's statement of inherency, and does not address examiner's arguments regarding the explicit teachings of Vega. The examiner will thus begin by focusing on the inherency argument.
3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the applicant's definition of "expertise") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
4. Examiner is required to define the terms according to their broadest reasonable interpretation, based on the definitions in the specification but not on examples or other limitations. The examiner defines the area of expertise to include any inability to complete the order, including the lack of expertise to gather the necessary resources. Applicant argues that Vega only teaches a lack of capacity, but a lack of capacity is a measure of expertise - the more one can output, the better their abilities. This argument is bolstered by claim 46, which clarifies

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that the company's expertise is dependent not only in its ability to complete the order in the abstract, but to complete the order within a certain cost and delivery schedule. If a company lacks capacity or resources, it lacks the expertise to produce at a certain time and budget, even if they have the expertise to produce in an instance where money and time are not important.

5. Even if one interpreted the term with sufficient narrowness that the feature was no longer inherent, the feature would still be obvious to try, and with predictable results. If Vega teaches the ability to contact a second provider because of lack of capacity, then one of ordinary skill in the art using plain common sense would know that you could also contact the second provider if you lacked the correct machine.

6. The above statement alone is sufficient to maintain the rejection. But for the purposes of advancing prosecution, the examiner will assume, for this section only, that lack of expertise is defined as being outside a core function of ability, such that the item cannot be produced regardless of capacity.

7. In response to applicant's argument that Vega does not show contacting second providers if they lack the expertise, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

8. Applicant has failed to show that the structure or functionality of contacting a provider due to lack of expertise is different from making a contact due to lack of capacity, particularly since both issues are related to the inability of the first provider to fulfill the request as given. At

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best, the applicant has focused on the information inside the messages or inside the comparison mechanisms.

9. However these differences are only found in the non-functional data stored on the article of manufacture. Data identifying the first service provider's problem is not functionally related to the substrate of the article of manufacture. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store any data in the fields of the article of manufacture as shown in Vega because such data does not functionally relate to the substrate of the article of manufacture and merely labeling the data differently from that in the prior art would have been obvious matter of design choice. *See In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

10. The above statement alone is sufficient to maintain the rejection. But for the purposes of advancing prosecution, the examiner will assume, for this section only, the extremely unlikely prospect that lack of expertise is defined as being outside a core function of ability, such that the item cannot be produced regardless of capacity, and that the requirement somehow results in a patentable difference. In other words, the examiner will show here that Vega does in fact clearly and expressly teach the claimed limitation.

11. The abstract clearly states that "the invention makes services freely tradable as goods via standardizing material terms describing such service transactions." In particular, the system

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“evaluates and matches the offer and the request for offer based upon the degree of identicalness of the set of service classification and material terms recited in the offer and request for offer,” and not on the identicalness of the services as the applicant misquotes. In other words, the abstract states that the comparison is between the customer’s (or first service provider's) request and the second service provider’s abilities, the request not limited by what the first service provider may normally do but cannot or will not do in this particular moment of time.

12. In interpreting Vega, applicant seems to be misinterpreting the idea of standardization. The purpose of the standardization is to make the various service providers use the same date format or same terminology for a given concept - it is to limit how the request is formed, not what can be requested. The purpose is in part to compare competing offers based on multiple criteria, including expertise as relates to quality, cost or delivery, and to allow for referrals with other members (col. 2, lines 15-35). The applicant is reminded that interpretation of Vega cannot be based on a phrase in isolation, but must be considered under Vega as a whole. “It is another purpose of this invention to offer strategic decision-making solutions that will help a participant of the service marketplace to coordinate services (col. 2, lines 50-65).”

13. Applicant also misinterprets "material terms" in the section wherein a first service provider and second service provider may make a deal. Such a group may be of a collection of realtors, architects, banks and construction services (col. 6, lines 1-15), each of which as a very different area of expertise beyond mere capacity issues. The whole purpose of this item is to allow a company to subcontract what it cannot do, i.e. the physical construction of a building. One of ordinary skill in the art, using common sense, would recognize that the planners and

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developers of a building would be unlikely to have expertise in the physical construction of a building.

14. Therefore, the rejections are maintained for the reasons above. This action is final.

***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

16. Claims 40-56 and 58-65 are rejected under 35 U.S.C. 102(e) as being anticipated by Vega et al. (7,272,575).

17. For claim 40, Vega teaches a method (abstract) for providing services over at least one network (col. 1, line 1 – col. 7, line 35) comprising the steps of:

- a. Providing a network service (col. 1, line 1 – col. 7, line 35) over the network (Figs 1-2; col. 7, line 35 – col. 8, line 55);
- b. Permitting at least one service group to access a network server via the network service, the service group including a plurality of members (col. 8, line 60 – col. 9, line 25);
- c. Registering each of the plurality of members and their provided services on the server (col. 9, lines 25-50);

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- d. Storing services information for each of the provided services on the server (col. 9, lines 50-67) together with its associated member including capability data, if any, for the associated member (col. 11, lines 1-55), and each of the members of the service group capable of being a service provider member and a service requestor member (col. 3, line 60 – col. 4, line 5);
- e. Allowing each requestor member to request services for a fee (col. 8, lines 58-60) from a provider member of the service group by submitting to the network service a service request including screening criteria comprising a requested service and at least one other criterion (col. 10, lines 1-40), wherein the requested service is partially outside of a submitting requestor's area of expertise but which is required to fulfill a non-member customer's order, and wherein the at least one other criterion was provided by the non-member customer in a customer service request (col. 13, line 15 – col. 14, line 20);
- f. Comparing the screening criteria with the services information and capability data stored on the server (col. 11, line 55 – col. 12, line 5);
- g. Identifying one or more matching providers whose services information and capability data most closely satisfies the screening criteria (col. 12, lines 5-20), wherein a combined collaboration between the submitting requestor and the one or more matching providers is required to fulfill the customer's order as provided in the customer service request (col. 13, line 15 – col. 14, line 20); and
- h. Verifying that the service request is submitted by a legitimate member of the service group and that the one or more matching providers is a legitimate member of the service group (col. 7, line 60 – col. 8, line 10).



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18. For claim 54, Vega teaches a method and system (abstract) comprising the steps of:
  - a. Providing a digital image (col. 8, lines 30-45) network service (col. 1, line 1 – col. 7, line 35) over a network (Figs 1-2; col. 7, line 35 – col. 8, line 55);
  - b. Permitting potential customers, using a communication device coupled to the network, to access a network server via the network service (col. 8, line 60 – col. 9, line 25);
  - c. Registering a plurality of service providers in a database of the server who are members of the network service (col. 9, lines 25-50), the registering step including storing service provider information for identifying each of the plurality of service providers (col. 9, lines 50-67), for describing each of their services (col. 9, lines 25-50) including service fees for potential retail purchasers and separate lower fees for potential wholesale purchasers (col. 8, lines 58-60), and for listing related service provider criteria (col. 11, lines 1-55) including areas of expertise (col. 13, line 15 – col. 14, line 20);
  - d. Allowing a potential customer to request services for a fee (col. 8, lines 58-60) from the plurality of registered service provider members by sending to the network service a service request via a communication device, the service request including a desired service and at least one screening criterion (col. 10, lines 1-40);
  - e. Comparing a received service request with the service provider information stored on the server (col. 11, line 55 – col. 12, line 5);
  - f. Identifying one or more matching members of the plurality of registered service provider members whose services, fees, and service provider criteria most closely match

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the desired service and the at least one screening criterion included in the received service request (col. 12, lines 5-20);

g. Verifying that the one or more matching members are current legitimate members in good standing of the network service (col. 7, line 60 – col. 8, line 10); and

h. Sending information for the one or more matching members to the potential customer's communication device for enabling the potential customer to select at least one of the matching members preferred by the potential customer to provide the desired service (col. 12, lines 20-60).

i. Sending a second service request by a selected one of said at least one of the matching members preferred by the potential customer for a desired service that is outside areas of expertise of the selected one of said at least one of the matching members and which requires an additional service provided by another service provider in collaboration with said selected one of said at least one of the matching members, wherein said selected one of said at least one of the matching members and said another service provider collaborate to provide the desired service for the potential customer (col. 13, line 15 – col. 14, line 20); and

j. Recording services performed by said selected one of said at least one of the matching members in response to the service request sent by the potential customer and services performed by said another service provider in response to the second service request sent by the selected one of said at least one of the matching members, and related fees owed, on the server (col. 13, line 15 – col. 14, line 20).

19. For claims 41, 55, Vega teaches a method further comprising the steps of:

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- a. Selecting one of said one or more matching providers by a submitter of the service request (col. 12, lines 20-60);
  - b. Forwarding information contained in the service request to the selected one of the matching providers (col. 14, line 20 – col. 15, line 20);
  - c. Performing the requested service by the Selected one of the matching providers (col. 14, line 20 – col. 15, line 20); and
  - d. Recording said performance and associated fees on the server (col. 14, line 20 – col. 15, line 20).
20. For claims 42, 56, Vega teaches a method further comprising the steps of:
  - a. Accumulating records for ongoing performances of requested services and their associated fees (col. 4, lines 60-65); and
  - b. Periodically distributing to each of the plurality of members of the service group the accumulated records of performed services and associated fees that pertain to services that said each member either requested or performed (col. 19, lines 5-35).
13. For claim 43, Vega teaches wherein said provided services pertain to digitally stored images (col. 9, lines 30-32).
14. For claims 44, 58, Vega teaches wherein said capability data includes a service provider's location (col. 4, lines 50-65).
15. For claims 45, 59, Vega teaches wherein said at least one other criterion includes a location of the requestor member and/or potential customer (col. 4, lines 50-65).
16. For claim 46, 60, Vega teaches wherein said capability data includes one or more of the following: Brand, Cost of service, Specific Product characteristics, Delivery time, Delivery

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method, Delivery reach, Specific provider characteristics, Work Flow Capacity, Access time, and Ability to ship to a specific location (col. 4, lines 50-65).

17. For claim 47, 61, Vega teaches the step of registering includes the step of submitting a business name and address to the network service by a service provider (col. 9, lines 25-50).

18. For claim 48, 62, Vega teaches the step of allowing each requestor member to request services includes the step of submitting an electronic message from a requestor member over the network service to the server via a network connected communication device (col. 8, lines 25-30).

19. For claim 49, 63, Vega teaches the step of identifying one or more matching providers includes the step of returning another electronic communication from the server to the requestor member containing a list of said one or more matching providers (col. 10, lines 1-40).

20. For claim 50, 64, Vega teaches said list of said one or more matching providers is arranged to more prominently list a provider who has paid an additional fee to the network service (col. 10, lines 55-65; col. 28, lines 28-45).

21. For claim 51, 65, Vega teaches the network connected communication device is a device selected from the group consisting of a personal computer, a cell phone, a kiosk, a camera, a minilab, and a PDA (col. 8, lines 45-50).

22. For claim 52, Vega teaches the submitted screening criteria from the requestor member including the requested service and the at least one other criterion is obtained from a customer service request submitted to the network service by a non-member customer (col. 28, line 45 – col. 29, line 35).

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23. For claim 53, Vega teaches the customer service request returned a list of one or more matching providers from the server that included the requestor member, which requestor member was selected by the non-member customer, and which requestor member received forwarded information from the customer service request (col. 28, line 45 – col. 29, line 35).

***Claim Rejections - 35 USC § 103***

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vega, as applied to claim 54 above.

26. For claim 57, Vega does not expressly disclose that the desired service is selected from the group consisting of: digital image enlargement; printing images on mugs; printing images on clothing; digital image printing; and framing for digital image prints. Vega does not place any limits on the type of service that may be performed (col. 5, line 50 – col. 7, line 35).

27. These differences are only found in the non-functional data stored on the article of manufacture. Data regarding the particular type of service to be sold is not functionally related to the substrate of the article of manufacture. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

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28. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store any data in the fields of the article of manufacture as shown in Vega because such data does not functionally relate to the substrate of the article of manufacture and merely labeling the data differently from that in the prior art would have been obvious matter of design choice. *See In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

29. The specific type of service being sold by a provider does not patentably distinguish the claimed system. Further, the recited statement of intended use, to focus on sellers of a particular service, does not patentably distinguish the claimed system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to sell any type of service in the system taught by Vega because the particular type of service sold does not patentably distinguish the claimed invention; a network system.

One may provide functionality such that the system must be limited to the sold item, i.e. uploading an image in the request and automatically producing a photo print the second that a deal is made. As the claims stand, however, the type of service being sold does not matter in respect to functionality.

### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELVIN H. POLLACK whose telephone number is (571)272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. H. P./  
Examiner, Art Unit 2145  
08 August 2008

/Jason D Cardone/  
Supervisory Patent Examiner, Art Unit 2145